MOTION FILED
MAY 4 1994

(2)

(1)

Sept. 26, 1994 List 3

No. 93-1577

In The

Supreme Court of the United States

October Term, 1993

QUALITEX COMPANY,

Petitioner,

v.

JACOBSON PRODUCTS CO., INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* AND BRIEF *AMICUS CURIAE*

David C. Gryce
Counsel for Dr Pepper/Seven-Up Corporation
MASON, FENWICK & LAWRENCE
1225 Eye Street, N.W., Suite 1000
Washington, D.C. 20005-3914
(202) 289-1200
In support of Petitioner

May 4, 1994

14pp

No. 93-1577

In The

Supreme Court of the United States

October Term, 1993

QUALITEX COMPANY,
Petitioner,

v.

JACOBSON PRODUCTS CO., INC.,
Respondent.

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE*

Pursuant to Supreme Court Rule 37.2, Dr Pepper/Seven-Up Corporation[1] ("Dr Pepper") hereby respectfully moves for leave to file the attached brief *amicus curiae* in support of Petitioner Qualitex Company's Petition for a Writ of Certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit ("Ninth

[1] The parent company of *amicus curiae* Dr Pepper/Seven-Up Corporation is Dr Pepper/Seven-Up Companies, Inc. Dr Pepper/Seven-Up Corporation has no nonwholly owned subsidiaries.

Circuit") in this case. Dr Pepper has sought the consent of the parties to file its brief *amicus curiae*. Petitioner has consented, and the original letter from Petitioner's counsel evidencing such consent has been filed with the Clerk of this Court. Respondent, Jacobson Products Co., Inc., refused to give its consent, in a letter of Respondent's counsel dated April 28, 1994, thereby necessitating this motion.

Dr Pepper has a long-standing interest in protecting its unique maroon color as a symbol of the goodwill it has developed in its **DR PEPPER** brand soft drinks. Dr Pepper depends upon the goodwill symbolized by its unique maroon color to promote its famous **DR PEPPER** brand soft drink products both nationally and internationally to the general consuming public. As a result of its national and international distribution of soft drink products, Dr Pepper's commercial interests are tied directly to its ability to promote and defend proprietary rights in distinctive symbols of its goodwill, including its unique maroon color.

In the instant case, Petitioner has described the conflict between the Ninth Circuit decision in *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (9th Cir. 1994) and decisions of the United States Court of Appeals for the Federal Circuit, *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985), and the United States Court of Appeals for the Eighth Circuit, *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993). This conflict among the circuit courts renders it impossible to achieve equal protection of the law for any party which has developed goodwill in its products or services symbolized by a distinctive color.

Moreover, the Ninth Circuit relegates color as a mark and symbol of goodwill to a "nether region," apart from

registrable marks, by invigorating a *per se* standard for color alone separate from the standard for other species of marks. The opinion of the Ninth Circuit poses a significant departure from the rules governing registrability under the Lanham Act, as discussed by this Court in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753, *reh'g denied*, 113 S.Ct. 21 (1992).

The conflict among the judicial circuits on the ability to appropriate a color alone as a trademark under the Lanham Act reaches far beyond the particular interests of the Petitioner and Respondent. The conflict effectively inhibits parties that claim a proprietary interest in a color alone from enjoying an ability to enforce such interests uniformly throughout the United States.

This brief *amicus curiae*, for which Dr Pepper is requesting permission to file, will further amplify the discussion regarding the effect of the current conflict among the circuits and address the Ninth Circuit's departure from established rules of law.

For the foregoing reasons, Dr Pepper respectfully moves for leave to file the attached brief *amicus curiae*.

Respectfully submitted,

David C. Gryce
Counsel for Dr Pepper/Seven-Up Corporation
MASON, FENWICK & LAWRENCE
1225 Eye Street, N.W., Suite 1000
Washington, D.C. 20005-3914
(202) 289-1200

May 4, 1994

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii

INTEREST OF THE *AMICUS CURIAE* 1

REASONS FOR GRANTING THE PETITION 2

I. THE CONFLICT AMONG THE CIRCUITS DEPRIVES PARTIES CLAIMING TRADEMARK RIGHTS IN A COLOR ALONE OF THE ABILITY TO ENJOY EQUAL PROTECTION UNDER THE LAW. . . . 2

II. THE DECISION OF THE NINTH CIRCUIT CONFLICTS WITH THE STATUTORY UNDERPINNINGS OF THE LANHAM ACT AND THIS COURT'S OPINION IN *TWO PESOS, INC. v. TACO CABANA, INC.* 5

CONCLUSION 8

TABLE OF AUTHORITIES

CASES

Page

DAP Products, Inc. v. Color Tile Manufacturing, Inc.,
821 F. Supp. 488 (S.D. Ohio 1993) 3-5

In re Owens-Corning Fiberglas Corp.,
774 F.2d 1116 (Fed. Cir 1985) 2, 3

Master Distributors, Inc. v. Pako Corp.,
986 F.2d 219 (8th Cir. 1993) 2

Nutrasweet Co. v. Stadt Corp.,
917 F.2d 1025 (7th Cir. 1990) 2

Qualitex Co. v. Jacobson Products Co.,
13 F.3d 1297 (9th Cir. 1994) 1, 2, 8

Qualitex Co. v. Jacobson Products Co.,
21 U.S.P.Q.2d 1457 (C.D. Cal. 1991) 3

Two Pesos, Inc. v. Taco Cabana, Inc.,
112 S.Ct. 2753, *reh'g denied*, 113 S.Ct. 21 (1992) 5-6, 7

STATUTES

15 U.S.C. § 1052 (Lanham Act, Sec. 2) 6-7

15 U.S.C. § 1125(a) (Lanham Act, Sec. 43(a)) 5

15 U.S.C. § 1127 (Lanham Act, Sec. 45) 6

Dr Pepper/Seven-Up Corporation ("Dr Pepper") respectfully submits this brief *amicus curiae* in support of the Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit ("Petition for a Writ of Certiorari") filed by Petitioner, Qualitex Company. Dr Pepper joins Petitioner in seeking a review of the judgment of the United States Court of Appeals for the Ninth Circuit ("Ninth Circuit") in *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (9th Cir. 1994).

The decision of the Ninth Circuit sets forth a *per se* rule that color alone cannot constitute a viable, registrable mark. In a multilingual world, color as a trademark is a universal language, especially in the realm of consumer products. Therefore, an issue of immense proportions is presented to this Court in this matter.

INTEREST OF THE *AMICUS CURIAE*

Dr Pepper enjoys substantial goodwill and renown for its soft drink products. Dr Pepper uses its unique maroon color as a distinctive symbol of the national and international goodwill and renown of its **DR PEPPER** brand products. The *per se* rule contained in the decision of the Ninth Circuit that color alone cannot form the basis of a valid trademark creates a barrier to Dr Pepper's ability to enforce proprietary rights in its unique maroon color. Moreover, without redress by this Court, Dr Pepper will not be able to enforce rights in its maroon color uniformly throughout the various circuits of the United States. Therefore, the Ninth Circuit opinion fosters a conflict among the circuits that impairs the value of Dr Pepper's proprietary rights in its maroon color

and weakens Dr Pepper's ability to defend its corresponding goodwill.

REASONS FOR GRANTING THE PETITION

I. THE CONFLICT AMONG THE CIRCUITS DEPRIVES PARTIES CLAIMING TRADEMARK RIGHTS IN A COLOR ALONE OF THE ABILITY TO ENJOY EQUAL PROTECTION UNDER THE LAW.

The conflict among the circuits discussed in Qualitex Company's Petition for a Writ of Certiorari involves whether color may form the basis of a valid and registrable trademark. As Qualitex Company has identified, the Ninth Circuit has joined the United States Court of Appeals for the Seventh Circuit in asserting a *per se* rule which precludes a finding that color alone may act as a valid, registrable mark.[1] These circuits directly conflict with the United States Court of Appeals for the Federal Circuit ("Federal Circuit") and the United States Court of Appeals for the Eighth Circuit.[2]

[1] *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (9th Cir. 1994), and *Nutrasweet Co. v. Stadt Corp.*, 917 F.2d 1025 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991).

[2] *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985), and *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993).

This conflict of law between the circuits, as outlined in the Petition for a Writ of Certiorari, limits one's ability to predict to what extent it may be able to protect and defend color alone as a trademark and encourages forum shopping. Dr Pepper, therefore, supports Qualitex Company's Petition for a Writ of Certiorari.

To demonstrate the burgeoning nature of this conflict, Dr Pepper notes the opinion of the United States District Court for the Southern District of Ohio in *DAP Products Inc. v. Color Tile Manufacturing Inc.*, 821 F. Supp. 488 (S.D. Ohio 1993), wherein the District Court relied upon the Federal Circuit opinion in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985), and held that there was no absolute prohibition on the registrability of color marks.[3] The court stated:

> In reaching this conclusion, the Court has carefully considered Color Tile's argument that the "color depletion" theory is applicable and that under that theory, color alone cannot be protected as a trademark. The color depletion theory assumes that new competitors would be precluded from entering an industry once all colors are used and protected.
>
> This Court is persuaded by the Federal Circuit's decision in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 [227 USPQ 417] (Fed. Cir. 1985). The *Owens-Corning*

[3] The court also relied upon the lower court decision *Qualitex Co. v. Jacobson Products Co.*, 21 U.S.P.Q.2d 1457 (C.D. Cal. 1991).

court engaged in an exhaustive analysis of the issue of registration of color, both pre- and post-Lanham Act, and concluded that there is no inherent bar against registering colors as trademarks. The *Owens-Corning* court did recognized [sic] the color depletion theory as an argument against the protection of color, but concluded that "contrary to an absolute prohibition on registrability of color marks, . . . each case [should be] decided upon its facts." *Id.* at 1120. The court also rejected the traditional shade confusion argument, stating that "deciding likelihood of confusion among color shades . . . is no more difficult or subtle than deciding likelihood of confusion where word marks are involved." *Id.* at 1123 (citation omitted).

The language of the Lanham Act is indeed broad as to what may be registered as a trademark: "[t]he term "trademark" [sic] includes any word, name, symbol, or device or any combination thereof . . . ." 15 U.S.C. § 1127. In view of this broad language, this Court agrees with the *Owens-Corning* court that there is no absolute prohibition on the registrability of color marks.

In the present case, the 3½ gallon red buckets do not make DAP's Type I mastic work any better, the red buckets are more expensive than other color buckets, specifically, white and black buckets, and there is no competitive need in the industry

for red buckets since other colors are equally usable. *See*, *Qualitex Co. v. Jacobson Products Co.*, 21 U.S.P.Q.2d 1457, 1991 WL 318798 (C.D. Cal. 1991).[4]

The problem of inconsistent results will continue unless abated by this Court, because the issue of trademark protection for color alone is not limited to the circumstances of the parties engaged in the particular case at bar. Therefore, the widespread effect of the current conflict among the circuits is a matter of significant importance that should be resolved by the Supreme Court of the United States.

II. THE DECISION OF THE NINTH CIRCUIT CONFLICTS WITH THE STATUTORY UNDERPINNINGS OF THE LANHAM ACT AND THIS COURT'S OPINION IN *TWO PESOS, INC. v. TACO CABANA, INC.*

In its decision, the Ninth Circuit affirmed that Respondent violated § 43(a) of the Lanham Act (15 U.S.C. § 1125(a)) under a theory of trade dress infringement, while holding that color alone cannot function as a valid trademark. This Court, in the case of *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753, *reh'g denied*, 113 S.Ct. 21 (1992), stated:

[4] *DAP Products, Inc. v. Color Tile Mfg. Inc.*, 821 F. Supp. 488, 494 (S.D. Ohio, 1993).

The Lanham Act was intended to make "actionable the deceptive and misleading use of marks" and "to protect persons engaged in . . . commerce against unfair competition" § 45, 15 USC § 1127 [15 USCS § 1127]. Section 43(a) "prohibits a broader range of practices than does § 32," which applies to registered marks, *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 US 844, 858, 72 L Ed 2d 606, 102 S Ct 2182 (1982), but it is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a) [citations omitted].[5]

This Court then discussed the definition of a trademark under 15 U.S.C. § 1127 and the requirements contained in 15 U.S.C. § 1052 concerning registration of marks. By linking the principles of § 43(a) of the Lanham Act to the definition of trademarks contained in 15 U.S.C. § 1127 and the requirements for registration contained in 15 U.S.C. § 1052, this Court established a framework which has been violated by the Ninth Circuit.

Section 2(f) of the Lanham Act (15 U.S.C. § 1052(f)) states, in pertinent part:

[5] *Two Pesos, Inc. v. Taco Cabana, Inc.*, 120 L. Ed. 2d 615, 623 (1992).

> Except as expressly excluded in paragraphs (a), (b), (c), (d), and (e)(3) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.[6]

This section further presents the legislative intent of the Lanham Act: to encourage liberal boundaries for the protection of any device which becomes distinctive of a party's goods or services. The Ninth Circuit's decision thwarts this intent.

The Ninth Circuit decided the question of trademark protection for color alone in a manner that conflicts with the statutory framework of the Lanham Act and the underpinnings of this Court's decision in *Two Pesos*. Thus, the Ninth Circuit's decision raises an important question of federal law which now must be settled by this Court.

[6] 15 U.S.C.A. § 1052(f) (West Supp. 1994).

CONCLUSION

For the reasons set forth above, a Writ of Certiorari should issue to review the judgment and opinion of the Ninth Circuit in the case styled *Qualitex Co. v. Jacobson Products Co.*, 13 F.3d 1297 (9th Cir. 1994).

Respectfully submitted,

David C. Gryce
Counsel for Dr Pepper/Seven-Up Corporation
MASON, FENWICK & LAWRENCE
1225 Eye Street, N.W. Suite 1000
Washington, D.C. 20005-3914
(202) 289-1200

May 4, 1994